



**UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/425,622	10/22/99	KING E	PCS10303AJTJ

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EXAMINER

SPEAR, J

ART UNIT	PAPER NUMBER
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1615

DATE MAILED: 01/18/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application No.

09/425,622

Applicant(s)

KING, ET AL.

Examiner

JAMES M. SPEAR

Group Art Unit

1615



☒ Responsive to communication(s) filed on Oct 22, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire THREE month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-21 and 24-30 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-21 and 24-30 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3,4

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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The drawings filed October 22, 1999 have been approved.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 24-27 and 30 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for methods of treating and products used in treating sexual dysfunction, does not reasonably provide enablement for prevention of sexual dysfunction. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to

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make and use the invention commensurate in scope with these claims. In presenting claims directed to prevention there is an implication of a 100 percent cure rate. Just as there is no known cure or means for preventing cancer, claims reciting prevention are outside the scope of what is considered acceptable medical practice. The specification does not show any evidence to support a means of prevention. Claims reciting prevention are not commensurate in scope with the disclosure.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

Claims 1-21 and 24-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Stella et al U.S. 6,046,177.

See Abstract, column 24, line 53. The examples show the various dosage forms of applicants. One skilled in the art would immediately envision incorporating sildenafil into said dosage forms to provide a controlled release sildenafil formulation. The formulation adjuvants are shown in columns 25-28.

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Osmotic pump tablets are shown in column 16, lines 17-38. The Stella et al dosage forms utilized the same conventional excipients including hydroxy propyl methylcellulose and Eudragit coatings. See columns 16-18.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-21 and 24-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stella et al U.S. 6,046,177.

Stella et al shows controlled release dosage forms as explained above. The reference further shows conventional excipients and active agents including sildenafil. A specific dosage form of sildenafil is not shown. Stella et al does show it is well known to incorporate drugs into the controlled release dosage forms for treating sexual dysfunction. The reference shows testosterone incorporated into an osmotic pump dosage form. See column 20, line 58 through column 21, line 4, example 11. It would have been obvious to one of ordinary skill in the art to

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incorporate sildenafil in place of testosterone in the osmotic pump dosage form of Stella et al. The motivation being a desire to obtain optimum effect in alleviating sexual dysfunction.

Claims 1-21 and 24-30 are rejected. Claims 22 and 23 have been canceled.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James M. Spear whose telephone number is (703) 308-2457. The examiner can normally be reached on Monday thru Friday from 6:30 A.M. to 3:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page, can be reached on (703) 308-2927. The fax phone number for this Group is (703) 305-3592 or 308-4556.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [thurman.page@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a

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possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308 1235.

James M. Spear

January 17, 2001

James M. Spear
JAMES M. SPEAR
PRIMARY EXAMINER
ART UNIT 1615